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| EXAMINER |
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AUVE, GLENN ALLEN

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 28

Application Number: 09/224,620
Filing Date: December 31, 1998
Appellant(s): MARISSETTY, SURESH K.

Jeffrey S. Draeger
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This Supplemental Examiner's Answer has been prepared as a result of the Board's remand of the original appeal to the Examiner to reconsider this issues in the case in light of the Board's decision in Ex Parte Eggert et al. (Paper No. 27). As a result of this reconsideration, the rejections of claims 51-56 and 58-94 based on impermissible recapture have been withdrawn, while the rejection of claim 57 has been retained. It is also noted that after the mailing of the original Examiner's Answer appellant filed a new reissue declaration on June 30, 2003, which remedied the defects noted previously. As a result the rejection of claims 1-35 and 51-94 based on a defective reissue declaration is being withdrawn.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. However it is noted that in the time since the Brief was filed in this case, the continuation application of this application (10/081,659) has also been appealed with similar issues.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is no longer correct in light of the Examiner's reconsideration of the claims on remand. The current status of the claims is: claims 1-35, 51-56, and 58-94 are allowed and claim 57 remains rejected under 35 USC § 251.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because appellant's invention as disclosed is a power management mechanism wherein a power management virtual device driver (PMVxD) is responsible for device idle detection and performs that idle detection using event timers that provide an indication of the activity level. The virtual device driver places idle local devices in a reduced power consumption state when no activity has occurred for a predetermined period of time (as is outlined in the abstract of the disclosure and see also col. 4, line 65 – col. 5, line 17). The entire disclosure is directed to this power

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management virtual device driver and the way in which it is operated to control the devices.

Appellant's summary of the invention attempts to describe the invention somewhat more broadly.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. However, only issues 3-13 really deal with the claim rejections which would seem to be appropriate issues for decision by the Board. Issues 1,2, and 14 appear to be legal questions which seem to be beyond the scope of the appeal. Certainly issues 1 and 2 are part of appellant's arguments with regard to issues 3-13 which deal with the claim rejections, and as such they will be treated with respect to the claim rejections.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 51-94 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). After reconsideration of the claims on remand, however, there is only one claim which remains rejected, therefore the issue of grouping the claims is moot.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 57 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 USC § 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As has been previously noted in this case, claim 57 omits the "virtual device driver" limitation which applicant argued in the parent patent made the claims allowable. Claim 57 contains limitations to power management software which "cooperates with said device manager to allow power management of a plurality of devices in the system which are configurable" however there are no limitations regarding the relationship between power management and configuration/reconfiguration. Claim 57 does not contain the relied-upon limitation added to the claims in the original application and repeatedly argued as distinguishing over the prior art, nor does the claim contain any broadened version of, or substantially equivalent substitute for, the omitted relied-upon limitation of the "virtual device driver". While claim 57 does contain the narrowing limitation of "allowing power management of a plurality of devices in the system which are configurable devices," this limitation only is directed to the types of devices which are power managed and it is in no way related to the "virtual device driver" limitation. Therefore claim 57 claims subject matter similar to the claims in the original parent application that did not have the

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"virtual device driver" limitation nor does it include limitations directed to the relationship between power management and configuration/reconfiguration.

Accordingly, claim 57 is more narrow than the claims in the original application in the recitation of the devices being configurable, however claim 57 completely omits the surrender-generating "virtual device driver" thereby making the claim broader than the original patent claims in an aspect germane to what was surrendered in response to a prior art rejection, and narrower in an aspect not germane to what was surrendered. Pursuant to *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), if a reissue claim is broader in an aspect germane to what was surrendered in response to a prior art rejection, but narrower in another aspect completely unrelated to what was surrendered, the recapture rule bars the claim. This is the understanding of how the shorthand set forth in *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 for the broadening scenario 3(a) is applied in light of *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) and *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), both of which pointed out that one should look at the limitation relied upon to define the invention over the prior art and determine if that limitation is omitted from the reissue claims. In the present case, similar to the facts in *Pannu*, the applicant has broadened the reissue claim 57 in an aspect germane to what was surrendered in response to the prior art rejection and has not narrowed the claim in the same area. Therefore, the decision in *Pannu* is relevant to the claim in this case because it provides an actual fact situation in which this scenario, where there was narrowing in a different area, was held to be impermissible recapture. The Board's decision in *Eggert*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003)(precedential decision of an expanded panel of the Board), on the other hand is not on point as to the issues at hand. In *Eggert*, the relied-upon limitation was not omitted in its entirety, but rather was broadened. Accordingly, the Board found the claims to

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escape the recapture doctrine. In claim 57, however, the relied-upon limitation was omitted in its entirety.

It is noted that unlike claims 51,64,70,73,74,80,86, and 94, claim 57 does not positively recite any limitations to a new focus of the invention, namely either the cooperation of the power management software with the device manager, or plug and play manager, to allow power management of devices that are configurable/reconfigurable, or the claimed relationship between power management and configuration changes of devices.

(11) Response to Argument

Issue 1. Does the recapture doctrine bar any broadening of a claim beyond a limitation that was added to overcome a prior art rejection, meaning that the reissue claim may not exclude the precise limitation that was added to overcome the prior art in the original patent?

As noted above, this is really not an "issue" in itself to be decided here. The question of this issue is treated with respect to the claim rejections in issues 3-13 to follow.

Issue 2. Did applicant "surrender" any and all subject matter that lacks the "virtual device driver" limitation?

As noted above, this is really not an "issue" in itself to be decided here. The question of this issue is treated with respect to the claim rejections in issues 3-13 to follow.

Issue 3. Does the recapture doctrine bar the claims of Group I (51,57,86,87,89)?

Appellant included claim 57 in this group of claims for argument, however, appellant only made arguments for this issue with respect to claim 51. Since claim 51 is no longer being rejected, a response will be made below with respect to claim 57.

When determining whether recapture exists various test have been devised by the courts. The facts in Pannu and Clement appear to be most relevant to the facts in the present case. Those courts developed what are basically three part tests for determining whether or not recapture exists. First, did applicant broaden the claims; secondly, if so, is the broadening related to what was surrendered during prosecution of the patent; and third, have the claims also been materially narrowed. In the present case the disagreement appears to lie in the question of whether or not the new limitations are materially narrowing or not.

The original or "surrendered" claim recites the use of a device driver for controlling power to various devices. The newly presented reissue claim does not include limitations drawn to the device driver or the virtual device driver limitation which was added in the amendment in order to make the patent claims allowable. Appellant freely added the virtual limitation to the claim and also argued it as the reason for allowability over the prior art. Even if only the original claim is what has been "surrendered", the claims in the reissue broaden even beyond that claim with respect to the fact that the reissue claims now only recite power management software, and the device driver limitations are not present. Therefore, the claims are broader in that respect. So, with regard to the first part of the test, appellant's claim 57 is broader than claim 11.

Next, it is necessary to determine whether the broader aspect of the reissue claim is related to the surrendered subject matter. Appellant's original claim was rejected over the prior art to Smith and Stewart which showed a system with device drivers monitoring devices and controlling power to them as noted in appellant's brief pages 33-34. This rejection was

overcome by adding the "virtual device driver limitation" to the claims. Therefore, the broadening removal of the device driver and virtual device driver limitations do broaden the claims in an aspect related to what was surrendered. The question then becomes whether or not the addition of the devices being configurable is a material narrowing which avoids recapture.

Appellant argues that the devices being configurable is a material narrowing over the surrendered subject matter, and suggests that power management of configurable devices was germane to the prior art and the prior art rejection. Appellant points to the fact that the original claim 35 was not rejected as evidence that the configurability limitation is a patentable feature by itself. However, it is noted that claim 35 is a dependent claim. Claim 29 from which it depends already included the virtual device driver limitation which the examiner indicated as the allowable feature, therefore no rejection would have or could have been made to the limitations contained in claim 35. The fact that such a limitation directed to configurability is contained in the original patent also would seem to indicate that this limitation was not overlooked by applicant in the original patent. Therefore, it is not clear that adding claims directed to this configurable limitation is really an error which can be corrected by reissue.

However, in any event, the question of "material narrowing" remains to be resolved. It is submitted that the presence of the configurable device limitation in reissue claim 57 is not a material narrowing of the surrendered subject matter with respect to the prior art rejection. The rejection was related to the use of a device driver for controlling power to devices. The reissue claims are broader in that respect as noted above. The fact that other limitations have been added that are not related to either the use of a device driver or virtual driver, that is to say, the addition of the limitation that the devices are configurable, is not a material narrowing germane to the prior art rejection. Clement dealt with a similar issue in that the claims had been broadened with respect to the surrendered subject matter but had other narrowing limitations

added. There the court found that recapture did exist because on balance the claims were broader than they were narrower in a manner directly related to the subject matter surrendered throughout prosecution. Clement at 1167. The same sort of situation exists in the present case.

Similarly, the facts in Pannu also seem to mirror those in the present case. In the present case the addition of the configurable device limitations are not related to the use of a device driver for controlling power. **That is, the limitations are directed to aspects of the devices being controlled, not to the device driver which is performing the controlling.** In Pannu the court found that, "The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather to the positioning and dimensions of the snag resistant means." That court decided that this fact meant that, "The reissued claims were not narrowed in any material respect compared with their broadening." Such a statement also applies to reissue claim 57 in the present case in that the narrowing is with respect to the devices which are being controlled, not to the driver doing the controlling. Therefore, it is believed that impermissible recapture exists with respect to claim 57.

With regard to independent claims 51 and 86 from this group, the rejection under 35 USC § 251 as being an impermissible recapture has been withdrawn after reconsidering the case on remand. Claims 51 and 86 both omit the "virtual device driver" limitation, but they include limitations directed to power management software that "cooperates with said device manager to allow power management of a plurality of devices in the system (claim 86) which are configurable (claim 51)." While these claims are silent regarding the surrender generating "virtual device driver" limitation they do contain limitations directed to the cooperation of the power management software with the device manager to allow for power management of devices that are configurable. This claimed relationship is directed to a different focus of the invention not claimed before in any of the independent claims of the original application for

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patent. The fact situation involved with these claims falls within that of *B.E. Myers & Co. v. United States*, 56 USPQ2d 1110 (US CtFedClis 2000), in which the Federal Court of Claims permitted the complete removal of a limitation added to obtain the patent, where the replacement limitation provided a separate invention not surrendered in the original application. Since these claims are directed to a different invention and different focus than the claims in the original application, the recapture rejection has been withdrawn.

Issue 4. Does the recapture doctrine bar the claims of Group II (52,53,54,61)?

This issue is now moot given that the claims are no longer being rejected. The discussion above for claim 51 applies.

Issue 5. Does the recapture doctrine bar the claims of Group III (58,88,90,91)?

This issue is now moot given that the claims are no longer being rejected. The discussion above for claims 51 and 86 applies.

Issue 6. Does the recapture doctrine bar the claims of Group IV (63)?

This issue is now moot given that the claim is no longer being rejected. The discussion above for claim 51 applies.

Issue 7. Does the recapture doctrine bar the claims of Group V (56,64-68,80-83,94)?

This issue is now moot given that the claims are no longer being rejected. With regard to independent claims 64, 80, and 94, it is noted that they all omit the surrender generating "virtual device driver" limitation, however, they do contain limitations drawn to the influence of device configuration changes, as determined by a configuration manager, on power management. This

claimed relationship between power management and configuration changes of devices is directed to a different focus of invention not claimed in any of the independent claims of the original patent application (08/346,040). Because these claims are directed to a different invention and different focus than the original claims, impermissible recapture does not exist with regard to these claims.

Issue 8. Does the recapture doctrine bar the claims of Group VI (55,59,60,85)?

This issue is now moot given that the claims are no longer being rejected. The discussion above for claims 51 and 80 applies.

Issue 9. Does the recapture doctrine bar the claims of Group VII (69,84)?

This issue is now moot given that the claims are no longer being rejected. The discussion above for claims 64 and 80 applies.

Issue 10. Does the recapture doctrine bar the claims of Group VIII (70-72,79)?

This issue is now moot given that the claims are no longer being rejected.

Claims 70 omits the "virtual device driver" limitation, but includes limitations directed to power management software that "cooperates with said device manager to allow power management of a plurality of devices in the system after reconfiguration of the plurality of system devices." While these claims are silent regarding the surrender generating "virtual device driver" limitation they do contain limitations directed to the cooperation of the power management software with the device manager to allow for power management of devices that are reconfigurable. This claimed relationship is directed to a different focus of the invention not claimed before in any of the independent claims of the original application for patent. The fact

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situation involved with these claims falls within that of *B.E. Myers & Co. v. United States*, 56 USPQ2d 1110 (US CtFedClis 2000), in which the Federal Court of Claims permitted the complete removal of a limitation added to obtain the patent, where the replacement limitation provided a separate invention not surrendered in the original application. Since these claims are directed to a different invention and different focus than the claims in the original application, the recapture rejection has been withdrawn.

Issue 11. Does the recapture doctrine bar the claims of Group IX (74-78)?

This issue is now moot given that the claims are no longer being rejected.

Similar reasoning to that noted above for claims 51,70, and 86 applies to independent claim 74.

Issue 12. Does the recapture doctrine bar the claims of Group X (92,93)?

This issue is now moot given that the claims are no longer being rejected. The discussion above for claim 86 applies.

Issue 13. Does the recapture doctrine bar the claims of Group XI (73)?

This issue is now moot given that the claims are no longer being rejected.

Similar reasoning to that noted above for claims 51,70, and 86 applies to independent claim 73.

Issue 14. Is the Judicially created recapture doctrine inherently and irreconcilably inconsistent with the Reissue Statute, 35 USC § 251, which permits broadening of claims,

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and now devoid of its original purpose of ensuring comity to the prosecution history reading public?

As noted above, this is really not an "issue" in itself to be decided here in this appeal. This is a legal argument best left to the courts.

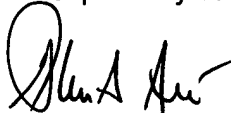
For the above reasons, it is believed that the rejection should be sustained.

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Respectfully submitted,



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